REMARKS

Claims 59-61 and 63-65 were examined and rejected. Claims 1-58 are cancelled and claims 62 and 66-87 are withdrawn.

Claims 59 and 61 are amended to further clarify the claimed invention. Support for the amendments to claim 59 is found in claim 1, as originally filed, and page 9, lines 8-17, page 9, lines 19-23, page 9, lines 27-28, page 5, line 9 to page 6 line 2, page 29, lines 25-27 and Figures 5A-5R. No new matter is added.

Applicants respectfully request reconsideration in view of the remarks set forth below.

Interview Summary

The Applicants wish to express their gratitude to Examiner Wessendorf for the interview on August 16, 2004, with Applicants' representative James Diehl.

Discussions focused on the state of the art, limitations of the art cited in the pending Office Action, and unexpected results over the art disclosed in the present application, in particular the successful activity of the inteins in mammalian cells. All current rejections were discussed, as well as arguments to overcome those rejections. Further details of the interview are discussed below.

The Applicants proposed to amend the claims to recite an intein of non-mammalian origin, and that the peptide cyclization could occur in a mammalian cell. The Examiner agreed to consider claims containing such an amendment.

Request for Interview

The Applicant respectfully requests a telephonic interview with Examiner Wessendorf *prior to* the mailing of the next Office Action, if any rejections remain after consideration of the arguments set forth below. The Applicant's representative James Keddie can be reached at (650) 833 7723.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 59-61 and 63-65 are rejected for failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The Applicants respectfully traverse this rejection.

Without wishing to acquiesce to this rejection and solely to expedite prosecution, claim 59 has been amended to recite a intein of *bacterial or yeast* origin. Further, claim 59 has been amended to require that the fusion protein is capable of producing a cyclic peptide in a *mammalian* cell.

Pursuant to the afore-mentioned interview and since such a system is exactly what the Applicants describe in their examples, it is believed that this rejection has been adequately addressed.

The Examiner is respectfully requested to consider the amendments to claim 59, and withdraw this rejection in view of those amendments.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 59-61 and 63-65 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office asserts that it is not clear if the peptide of interest is different from the cyclic peptide.

Without any intention to acquiesce to the correctness of this rejection and solely to expedite prosecution, claim 59 has been reworded for clarity.

The Applicants respectfully submit that this rejection has been adequately addressed and may be withdrawn.

The Examiner is respectfully requested to kindly suggest language that would be found more suitable if the amendments to claim 59 do not overcome this rejection.

Rejections under 35 U.S.C. § 103

Claims 59-61 and 63-65 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Scott or Evans in view of a patent by Nolan.

The Applicants submit that the subject matter of the cited Nolan patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Rigel. Accordingly, Nolan cannot preclude the patentability of the rejected claims, and this rejection may be withdrawn.

Support for this assertion is set forth below:

35 U.S.C. 103 (a) states that a patent may not be obtained if the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made[1]. 35 U.S.C. 103 (c), however, states that subject matter developed by another person shall not preclude patentability under 103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.[2]

According to 35 USC § 103(c), therefore, the Nolan patent cannot preclude the patentability of the rejected claims if the Nolan patent and the instant application were assigned to the same person or subject to an obligation of assignment to the same person, at the time the instant invention was made.

The invention claimed in the instant patent application was owned by Rigel, Inc. ("Rigel") or subject to an obligation of assignment to Rigel at the time the instant invention was made, as evidenced by an assignment to Rigel executed by the inventor and recorded on August 23, 2001 (Reel/Frame 012115/0311; Exhibit A).

The Nolan patent was owned by Rigel or subject to an obligation of assignment to Rigel at the time the instant invention was made, as evidenced by an assignment to Rigel executed by the inventor and recorded on October 14, 1997 (Reel/Frame 8875/0682; Exhibit B).

Thus, the Nolan patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Rigel. Accordingly, the Nolan patent cannot preclude patentability of the instant claims under 103(a).

In view of the disqualification of Nolan patent as a prior art reference, this rejection of claims 59-61 and 63-65 under 35 U.S.C. § 103(a) may be withdrawn.

---

[1] 35 U.S.C. 103(a) : A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[2] 35 U.S.C. 103(c): Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Summary

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-022.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: January 5, 2005

By: _____
James S. Keddie, Ph.D.
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Enclosures: Exhibit A Recordation of Assignment Reel/Frame 012115/0311;
Exhibit B Recordation of Assignment Reel/Frame 8875/0682

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NOVEMBER 01, 2001

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Exhibit B

FLEHR HOHBACH TEST
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RECORDATION DATE: 08/27/2001

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BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
KINSELLA, TODD M.

DOC DATE: 08/23/2001

ASSIGNEE:
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94080

SERIAL NUMBER: 09800770
PATENT NUMBER:

FILING DATE: 03/06/2001
ISSUE DATE:

STEVEN POST, EXAMINER
ASSIGNMENT DIVISION
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Exhibit A

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RECORDATION DATE: 10/20/1997

REEL/FRAME: 8875/0862
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
NOLAN, GARRY P.

DOC DATE: 10/14/1997

ASSIGNEE:
RIGEL PHARMACEUTICALS
772 LUCERNE DRIVE
SUNNYVALE, CALIFORNIA 94086

SERIAL NUMBER: 08789333
PATENT NUMBER:

FILING DATE: 01/23/1997
ISSUE DATE:

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